

REMARKS

Claims 1-3, 7 and 11 are pending in this application. By this Amendment, claims 8 and 9 are amended. Support for the amendments to the claims may be found, for example, in the specification at pages 12 and 13. No new matter is added.

Entry of the amendments is proper under 37 CFR §1.116 because the amendments: (a) place the application in condition for allowance (for the reasons discussed herein); (b) do not raise any new issue requiring further search and/or consideration (as the amendments amplify issues previously discussed throughout prosecution); (c) satisfy a requirement of form asserted in the previous Office Action; (d) do not present any additional claims without canceling a corresponding number of finally rejected claims; and (e) place the application in better form for appeal, should an appeal be necessary. The amendments are necessary and were not earlier presented because they are made in response to arguments raised in the final rejection. Entry of the amendments is thus respectfully requested.

In view of the foregoing amendments and following remarks, reconsideration and allowance are respectfully requested.

I. Rejections Under 35 U.S.C. §112

A. 35 U.S.C. §112, First Paragraph

The Office Action rejects claims 1-3, 7-9, and 11 under 35 U.S.C. §112, first paragraph, for failing to provide an enabling disclosure for (1) a wall strengthener that lacks the modified silicone oil and the materials of claim 10, now recited in claim 1, and (2) the term "special." Applicants respectfully traverse the rejections.

B. Wall Strengthener

The Office Action asserts that the specification appears to require both the modified silicone oil and one of the materials of claim 10, now recited in claim 1, because the

specification discloses no other amphipathic liquid except a modified silicone oil. See Office Action, page 3. Applicants respectfully disagree.

The amphipathic liquid, recited in claim 1, has "both the hydrophilic and hydrophobic groups, for example, modified silicone oil in which a hydrophilic organic group has been introduced." See specification, page 7, lines 11-16. Modified silicon oil is a nonionic amphipathic liquid. See specification, page 11-25 to page 12, line 5.

The nonionic amphipathic liquid compound includes all amphipathic liquid compounds whose hydrophilic groups are nonionic. Above all, modified silicone oil is preferable in which the hydrophilic organic group has been introduced (all introduction modes such as replacement and addition are included) from viewpoints of dispersibility of the above-described partition wall strengthening material and influence thereof on the water-soluble organic binder.

Applicants' disclosure recites amphipathic liquids other than nonionic amphipathic liquids. Specifically, Applicants disclose "a dispersion medium mainly composed of a nonionic amphipathic liquid compound, an anionic amphipathic liquid compound, a cationic amphipathic liquid compound, or an ampho-ionic amphipathic liquid compound." See specification, page 11, lines 12-19 (emphasis added). One of ordinary skill in the art would recognize that modified silicon oil is not an anionic amphipathic liquid compound, a cationic amphipathic liquid compound, or an ampho-ionic amphipathic liquid compound. Additionally, replacing a nonionic amphipathic liquid, such as modified silicone oil with other amphipathic liquid compounds would not require undue experimentation for one skilled in the art because the other amphipathic liquid compounds are well known in the art.

Thus, the disclosure would enable one of ordinary skill in the art to practice the claimed invention with not only non-ionic amphipathic liquid compounds but also anionic amphipathic liquid compounds, a cationic amphipathic liquid compounds, or an ampho-ionic amphipathic liquid compounds.

Furthermore, MPEP §2164.01(b) recites:

As long as the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim, then the enablement requirement of 35 U.S.C. §112 is satisfied. Failure to disclose other methods by which the claimed invention may be made does not render a claim invalid under 35 U.S.C. §112.

As indicated by page 7, lines 11-16 of Applicants' specification and claim 3, the modified silicone oil is an embodiment of the amphipathic liquid. The Office Action acknowledges that modified silicone oil is enabled by Applicants' specification. See Office Action, page 2. Because Applicants' specification discloses one method for manufacturing a honeycomb structure, i.e. the method using modified silicone oil, the enablement requirement of 35 U.S.C. §112 is satisfied.

Thus, for at least the reasons discussed above, Applicants respectfully submit that one skilled in the art would be able to make and use the claimed honeycomb structure, commensurate in scope with the current claims, without undue experimentation. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

C. Special

As indicated above, the Office Action rejects claims 1-3, 7-9 and 11 under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement because the meaning of "special," recited throughout the specification, is unclear. By this Amendment, and without conceding the propriety of the rejection claims 8 and 9 are amended in light of the Examiner's comments. Accordingly, reconsideration and withdrawal of the rejection are requested.

II. 35 U.S.C. §112, Second Paragraph

The Office Action rejects claims 8 and 9 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter

which Applicants regard as the invention. By this Amendment, as described above, claims 8 and 9, are amended in light of the Examiner's comments. Accordingly, reconsideration and withdrawal of the rejection are requested..

III. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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Attachments:

Petition for Extension of Time
Notice of Appeal

Date: October 27, 2008

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